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EXAMINER

MICHALSKI, SEAN M

ART UNIT	PAPER NUMBER
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3724

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01/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/741,521

Applicant(s)

VEGLIANTE ET AL.

Examiner

Sean M. Michalski

Art Unit

3724

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-10 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. Since applicant has not filed a terminal disclaimer, and indicates that such will be filed only upon the allowance of claims, Claim 1 is still found to be provisionally rejected on the basis of nonstatutory obviousness type double patenting over claim 12 of co-pending application 09/790,015 in view of Lucas (5,440,961; Lucas hereinafter). As set forth in the previous action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 8-10, 12-15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Urion (4,210,043) Tsai (5,036,740) as set forth in the previous action (Dated 07/03/07).

The inclusion of subject matter from claim 11 in claims 1 and 19, and the cancellation of claim 11 does not in any way affect the propriety of the rejection as applied.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda

(5,524,515), Urion (4,210,043) Tsai (5,036,740) as set forth above, and further in view of Chuang (4,960,022) as set forth in the previous action (Dated 07/03/2007).

5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Urion (4,210,043) Tsai (5,036,740) as set forth above, and further in view of Chiu (5,398,576) as set forth in the previous action (Dated 07/03/2007).

Response to Arguments

6. Applicant's arguments filed 12/06/2007 have been fully considered but they are not persuasive.

In response to the allegation that "it is obvious to one of ordinary skill in the art that the vinyl spots play no roll in cutting the film" (pp. 6 line 2 of remarks) this is both untrue, and irrelevant to the issue of patentability. The rejection cited Wankow as teaching the properties of the material, so the operation of the device *generally* is **irrelevant** to the rejection. The pertinent facts of Wankow are that the ***material behaves in a way known to one of ordinary skill; it attracts the film.*** It is also **untrue** that the spots play no part in the cutting, Since their presence in the *system of Wankow* allows for a certain behavior in the cling of the film during the operation. The use of vinyl spots is directly related to the cutting step, it is provided specifically for post cutting holding of the film. See *KSR International v. Teleflex inc.* 550 U.S. ____ (2007) slip op at 13, lines 22-34 which states "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the

same way, using the technique is obvious". Similarly here, In the Wankow device the vinyl was used to hold the film from falling back into the box, however a person of ordinary skill would recognize that in *a different type of device---such as a rail style cutter also known in the art* it would be advantageous to use the *known property of the vinyl attraction to retain the film in place during rail style cutting*. The arguments presented as to a "lack of teaching or suggestion" are not in accordance with law since The Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007), 82 USPQ2d at 1396, **foreclosed the argument that a specific teaching suggestion or motivation is required** to support a showing of obviousness. See the Board decision *Ex parte Smith* –USPQ2d–, slip op at 20, (Bd. Pat. App. & interf. June 25, 2007).

The argument that "Wankow teaches ...away from the present invention", is without merit. Teaching away, as a principle, is when a reference forbids, or applies a statement of negative value to a property or device. Such as "____ would never work"; "____ would be folly since it would cause death". Positive statements of a different desired concentration *are not considered to be evidence that they teach away from other concentrations*. This is not the meaning of teaching away under the Graham analysis.

The allegation that "neither of the references teach the structure of a rail having cling properties in combination with a rail having durability properties" is also unpersuasive, since the *combination of references in view of the ordinary skill in the art has established the prima facie case*. Allegations that individual references do not teach

certain elements are not persuasive when the combination *does and has taught the required claim elements*.

Again on pp. 7 of the comments, applicant has argued against the combination by attacking the references individually; which is not a persuasive argument in accordance with well established law (See *In re Keller*, 208 USPQ 871 (CCPA 1981)). The argument that Chiu does not "cure the deficiencies" of the underlying rejection is likewise completely unpersuasive.

7. Applicant's affidavit has been fully considered but is considered wholly unpersuasive.

Regarding 4, it is irrelevant how many SAFTY SLIDE CUTTER units you have sold. The conclusory statement "presents a very novel cling of plastic wrap to the film cutter" is weighed against the balance of the prima facie case in the record, and the self serving nature of statements by the assignee of an application.

Regarding 5, the "numerous inquiries from ...distributors" (etc.) is irrelevant, since you have not made any connection between the requests and the nexus of the invention. Nor have you established any basis of evaluating the term "numerous". Is 10 requests for information numerous? Does that prove anything?

Regarding 6, assignee states "An important feature highly appreciated by the customers..." but presents **no evidence or evaluation criteria** for that judgment, rendering the opinion of the affiant unreliable; (in consideration of the self serving nature of affidavits by assignees to applications). It is also hearsay evidence, and as such should be considered accordingly. Presumably if affiant has access to 'customers' and

can form opinions about what they "highly appreciate" affiant could have tabulated results to a survey (which is more direct evidence from a customer), or perhaps had them state on their own that they appreciate a certain feature. While the rules of evidence do not apply to administrative proceedings, it is curious to note that affiant *chose* not to submit evidence of a more concrete nature, such as survey results- which would at least have shown the methodology used to generate such data.

Regarding 7, the conclusory statement that "this statement is incorrect" (line 5) is without evidence. See MPEP 2107.02 which states "...declarations in which conclusions are set forth without establishing a nexus between those conclusions and the supporting evidence, or which merely express opinions, may be of limited probative value with regard to rebutting a prima facie case. In re Grunwell, 609 F.2d 486, 203 USPQ 1055 (CCPA 1979); In re Buchner, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991)." The statement that the vinyl spots play no roll in cutting the film is erroneous, since they are used *in a film cutter, in the process of cutting film, for the purpose of holding film after it has been cut*. This is a direct advantage to the user in the *process of cutting film*. It allows for convenient holding of the film between movements of the film. The result that the film sticks to a rail made from the same material the dots were made of was completely predictable based on the available evidence at the time of the invention. The fact that the dots were used in a different method in Wankow does not mean that it was unobvious to use the **material** for the same effect (stationary holding) in a different *known* device.

Regarding the "opinion" expressed at 8 by affiant that the product can be termed a commercial success, and that there has been a long felt need, what evidence is there to support this contention? None in the record. See MPEP 2107.02 which states "For example, declarations in which conclusions are set forth without establishing a nexus between those conclusions and the supporting evidence, or which merely express opinions, may be of limited probative value with regard to rebutting a prima facie case. In re Grunwell, 609 F.2d 486, 203 USPQ 1055 (CCPA 1979); In re Buchner, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991)".

While the statements regarding the lack of promotion and advertising are tantalizing, they do not cement the commercial success claim without *also* showing that market share has increased *as a direct result of the product features claimed*, or some other quantifiable metric has been met, and a showing that the metric chosen is relevant to the inquiry. It is highly unlikely that the product has been successful due to the fact that there is a 10% plasticizer in the rail; or any other feature specifically or in combination; for that reason, some evidence besides the statements of an affiant who stands to benefit from the grant of a patent (the assignee) is necessary to overcome the (quite convincing) prima facie case of obviousness that has been maintained in this case.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMM



KENNETH E. PETERSON
PRIMARY EXAMINER